Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOHANNES P. VERDUIJN, GARY B. MCVICKER and JOHN J. ZIEMIAK,

Appeal No. 2000-1808
Application No. 07/855,016 [1]

ORDER REMANDING TO EXAMINER

Before KIMLIN, PAK, and OWENS, Administrative Patent Judges.

PAK, Administrative Patent Judge.

REMAND TO THE EXAMINER

On this record, we determine that this case is not ripe for meaningful review and is, therefore, remanded to the examiner for appropriate action consistent with the view expressed herein.

[1] Application for patent filed June 30, 1992.

The subject matter on appeal is directed to a process for reforming a hydrocarbon feed stream in the presence of a crystalline Zeolite KL catalyst impregnated with a metal hydrogenation-dehydrogenation promoter. Further details of this subject matter are provided in representative claim 1 which is reproduced below:

> 1. A process for reforming a petroleum hydrocarbon feed stream comprising contacting the stream under reforming conditions with a catalyst which comprises a zeolite KL in which the Zeolite crystals are cylindrical and have an average cylinder wall length of 0.1 to 0.6 microns, and an average cylinder wall length: diameter ratio of less than 0.5 and have microscopically flat basal planes, said Zeolite being the crystallization product of a mixture comprising q moles of water, a divalent cation, said divalent cation present in said mixture and present at a level of up to 250 ppm, a source of m moles of K_20, a source of n moles Of $Si0_2$ and a source of m moles of AL_20_3 where m:n is 0.2 to 0.35 and n:p is 15 to 160 and q:m is 45 to 70, which zeolite is further impregnated with a metal hydrogenation-dehydrogenation promotor, wherein the basal planes of said cylindrical crystals are flatter than the basal planes of crystals prepared from an otherwise identical synthesis mixture which is free of said divalent cation.

As evidence of unpatentability, the examiner relies on the following prior art references:

Wortel	4,544,539	Oct. 01, 1985
Buss	4,645,586	Feb. 24, 1987
Ellig et al. (Ellig)	4,870,223	Sep. 26, 1989
Drehman et al. (Drehman)	5,231,268	Jul. 27, 1993
Verduijn	5,491,119	Feb. 13, 1996

The examiner has rejected the claims on appeal as follows:

1) Claims 1 through 4, 6 through 10 and 23 through 28 under 35 U.S.C. § 103 as unpatentable over the disclosure of Wortel;

2) Claims 11 through 16 and 28 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Buss and Wortel;

3) Claims 17 and 18 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Buss, Wortel and Drehman;

4) Claims 19 through 21 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Buss, Wortel and Ellig; and

5) Claims 1 through 4 and 6 through 10 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 20 through 30 of Verduijn.

In response to these rejections, appellants refer to, *inter alia*, a terminal disclaimer which is said to be concurrently filed with their Brief. See, e.g., the Brief, page 5. Specifically, the appellants assert (*Id.*) that:

> Appellant has submitted concurrently herewith a Terminal Disclaimer which disclaims the term of any patent which may issue based on the present application which would extend beyond the February 13, 2013 expiration date of U.S. Patent 5,491,119. It is believed that this action renders moot the rejection of claims 1-4 and 6-10 based on obviousness - type double patenting. It is respectfully requested that the Examiner enter this disclaimer of record.

The examiner, however, has not indicated the status of the terminal disclaimer in question, much less responded to the appellants' assertion above. See the Answer in its entirety.

Nor has our cursory review revealed the existence of the terminal disclaimer in question in the instant application.

Upon return of this application, the examiner is to clarify the status of the terminal disclaimer in question and provide a response to the appellants' assertion above. Pursuant to 37 CFR § 1.193(b)(1), we authorize the examiner to supply a Supplemental Examiner's Answer for the above-mentioned purposes.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(d)(8th Ed., Aug. 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMAND

EDWARD C. KIMLIN Administrative Patent Judge	)	
CHUNG K. PAK Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
TERRY J. OWENS Administrative Patent Judge	)	

CKP:vsh

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